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Docket No.
448563/0163

LR:DLS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Minoru Usui et al.

Art Unit: 2863

Application No.: 09/312,073

Examiner: Michael P. Nghiem

Filed: May 13, 1999

For: INK CARTRIDGE FOR INK-JET PRINTING APPARATUS

Date: March 18, 2005

REMARKS ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the timely-filed Request for Continued Examination ("RCE") filed herewith, Applicants respectfully submit the following remarks regarding comments contained in the Advisory Action mailed on March 8, 2005.

The RCE requests entry of the Amendment After Final Rejection filed on February 16, 2005, which responded to the Office Action mailed on October 20, 2004. In part, that Amendment After Final traversed the rejection of claims 15, 23 and 58 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,270,207 to Sasaki.

Applicants' response pointed out Sasaki is not prior art under 35 U.S.C. § 102(e) because one of the Japanese priority applications for this case, JP 10-131483, was filed on May 14, 1998, whereas Sasaki was filed on March 29, 1999, after this earlier priority date (the claimed invention is supported by that Japanese application). Accordingly, Sasaki is not prior art. In accordance with 37 C.F.R. § 1.55(a)(4), a sworn English translation of the priority document was submitted.

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U.S. Patent Appln. 09/312,073
Remarks Accompanying Request for Continued
Examination filed March 18, 2005

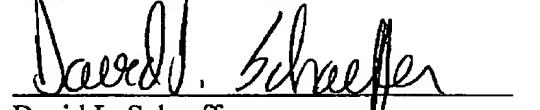
Thus, the statement in Section 11 of the March 8 Advisory Action "The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Sasaki (US 6,270,207) does not claim priority to Japanese application JP 10-131483, which is a priority document of the instant application" is not understood. Applicants did not say Sasaki claimed priority to JP 10-131483, they said the present application does.

M.P.E.P. § 2136.03(I) specifically states that when applying a U.S. patent in a § 102(e) rejection, the foreign priority of the U.S. patent is not considered¹. So Sasaki's priority is not relevant - all that matters is that Applicants' claimed invention is supported by a priority application with a filing date earlier than Sasaki's effective U.S. filing date (here, May 14, 1998 and March 29, 1999, respectively).

Accordingly, this rejection has been overcome and must be withdrawn.

Prompt and favorable consideration of this application are respectfully requested.

Respectfully submitted,



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¹ M.P.E.P. § 2136.03(I) reads in part "35 U.S.C. 102(e) is explicitly limited to certain references 'filed in the United States before the invention thereof by the applicant' (emphasis added). Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date." (emphasis added)